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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,334	06/10/2000	STEFAN ROVER	18645-00023	6673

7590 01/17/2006
ARMSTRONG TEASDALE LLP
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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT PAPER NUMBER

2137

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/530,334

Applicant(s)

ROVER ET AL.

Examiner

Minh Dieu Nguyen

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-40 and 46-48 is/are allowed.
- 6) ☒ Claim(s) 41-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the RCE dated March 21, 2005 with the amendments to claims 13 and 34 and the cancellation of claims 1-12.

Claims 13-48 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 41-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonstromer (6,142,369).

a) As to claim 41, Jonstromer discloses a method for conducting electronic financial transactions using a smartcard with mobile phone (i.e. a method for operating a wireless device) comprising receiving a message (col. 4, lines 25-27); displaying at least a portion of the message (it is inherently understood that the message is displayed on a visual display unit, Fig. 1, element 6); accepting input from the user indicating the received message is to be signed (col. 4, lines 28-32, lines 42-44); generating a

corresponding signed message (col. 4, lines 32-35) and transmitting the signed message (col. 4, lines 35-42).

b) As to claims 14, 25, 35, 40 and 42, Jonstromer discloses the public key process is used for signing (col. 4, lines 47-52), particularly a public key process in which the signing unit has an associated secret key (col. 4, lines 37-41) and , in particular, the receiver has a corresponding public key so that the signed message transmitted to the receiver can, optionally, be compared with the original message and identified as authentic (col. 6, lines 36-41).

c) As to claims 43-44, Jonstromer discloses the memory for storing the algorithm is located within a chip card of the wireless device (col. 1, lines 28-44, i.e. chipcard acts as a SIM for the mobile phone, SIM carries a variety of information including asymmetric ciphers, keys for encryption and electronic signing).

d) As to claims 45 and 47, Jonstromer discloses the wireless device is a mobile radio telephone (Fig. 1, element 4).

Allowable Subject Matter

4. Claims 13-40 and 46-48 are allowed.

The prior arts of Jonstromer (6,142,369) and Kawan (5,796,832), by themselves or in combination fail to disclose transmitting from a transmitter a message to be signed to a first receiver and transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone comprising a signing unit as claimed in claims 13, 22, 33, 34, 39 and 46.

As to any claims not specifically discussed, they are allowed because they depends on one of the claims discussed above.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.


mdn

1/5/06

Minh Dieu Nguyen
Examiner
Art Unit 2137


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER